

## **REMARKS/ARGUMENTS**

The Office Action mailed June 7, 2005 has been reviewed and carefully considered. Claims 2 and 3 are canceled. Claims 1 and 6 have been amended. Claim 11 is added. Claims 1, 4-11 are pending in this application, with claim 1 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1 and 4-10 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 3,945,663 (Duckett) in view of U.S. Patent No. 4,240,654 (Gladieux).

Independent claim 1 recites "a piston-cylinder assembly of a suspension system for a motor vehicle" and a connecting element "connected to said enclosed envelope and non-detachably inserted into a bore in said piston rod guide for connecting said enclosed envelope to a flow connection, said bore having a circumferential groove and a resilient securing ring in said groove, said connecting element having a shoulder which is engaged by said securing ring to prevent withdrawal of said connecting element from said bore".

The combined teachings of Duckett and Gladieux fail to teach or suggest a connecting element connected to said enclosed envelope of a piston-cylinder assembly of a motor vehicle. As acknowledged by the Examiner in the Office Action, Duckett discloses a strut with an enclosed envelope connected to an inlet but lacks the connecting element recited in independent claim 1. The Examiner alleges that it would have been obvious to include a bore in the piston rod guide with a non-detachably connected connecting element such as the connecting element of Gladieux.

As noted in the MPEP § 2143, the prior art reference (or references when combines) must teach or suggest all the claim limitations. The teaching or suggestion to make

the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner alleges that connecting element and snap ring are notoriously known in the art. While that may be true, it is respectfully submitted that these known connecting elements are used for connecting the ends of hoses, tubes, or conduits. For example, Gladieux discloses a connector for air brake hoses in a truck. Accordingly, Gladieux fails to teach anything about arrangement of a connecting element within a strut of a motor vehicle. Applicant respectfully submits that the combined disclosures of Duckett and Gladieux teach or suggest a connecting element connected to an enclosed envelope of a piston-cylinder assembly of a suspension system for a motor vehicle and "non-detachably inserted into a bore in said piston rod guide for connecting said enclosed envelope to a flow connection, said bore having a circumferential groove and a resilient securing ring in said groove, said connecting element having a shoulder which is engaged by said securing ring to prevent withdrawal of said connecting element from said bore", as expressly recited in independent claim 1.

In view of the above amendments and remarks, it is respectfully submitted that independent claim 1 is allowable over Duckett and Gladieux.

Dependent claims 4-12, each being dependent on independent claim 1, are allowable for the same reasons expressed above with respect to independent claim 1.

Dependent claim 6 recites "a bushing fixed directly to a side of said bore, said bushing defining a side of said groove". Gladieux discloses a bore having a split ring 40 arranged in a groove 41 that is defined entirely by the socket fitting 30. Gladieux fails to teach or suggest that the groove 41 in which the split ring is arranged is formed by a bushing in the bore. Accordingly, neither Duckett nor Gladieux teach or suggest "a bushing fixed directly to a side of said bore, said


bushing defining a side of said groove", as expressly recited in independent claim 6. The Examiner further refers to Cunningham as a reference showing a bushing. However, Cunningham also fails to teach or suggest "a bushing fixed directly to a side of said bore". In contrast, Cunningham discloses a flanged washer 33 that is not fixed directly to the side of the bore. In contrast, washer 33 is held in place by a threaded tube nut 35 (see Figs. 1 and 2; and col. 2, line 66 - col. 3 line 14 in Cunningham).

New dependent claim 11 recites that the "bore is a drilled hole, said groove being defined by said bore and said bushing". In contrast, Cunningham teaches a threaded hole and a groove defined entirely by the flange washer 33 and the tube nut 33.

In view of the above amendments and remarks, the application is now deemed to be in condition for allowance and notice to that effect is earnestly solicited.

Respectfully submitted,

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